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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,848	08/15/2005	Patrick Moireau	263780US0PCT	8635
22850	7590	03/19/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GRAY, JILL M	
			ART UNIT	PAPER NUMBER
			1774	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/19/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/19/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/519,848

Applicant(s)

MOIREAU ET AL.

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/13/05, 3/21/05, 4/28/05</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

3. The abstract of the disclosure is objected to because it should be a single paragraph and because of the legal phraseology "comprising". Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2, 5, 9-10, 12-16, 19, and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent

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protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "fatty acid contains 10 to 24", and the claim also recites "preferably 14-22", which is the narrower statement of the range/limitation.

In claim 5, the language of "preferably equal to 0.3 or 6" is indefinite for reasons stated above with claim 2.

In claim 9, the language of "preferably greater than or equal to 8%" is indefinite for reasons stated above with claim 2.

In claim 10, the language of "preferably 5 to 30% and advantageously 8 to 25%" is indefinite for reasons stated above with claim 2.

Claim 12 is indefinite because the range "between 0 and 20% by weight" does not indicate what the basis is. For example, whether this is by weight of the composition.

In claim 13 the range "from 0 to 40%" is indefinite because it does not contain units of measurements.

7. Regarding claim 14, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. Also, the language of "containing less than 5% water" is indefinite because the units of measurement are not clear. For example, it is not clear whether this refers to volume or weight percent.

In claim 15, the language of "preferably between 50 and 100×10^{-3} Pa.s" is indefinite for reasons stated above with claim 2.

In claim 16, the language of "preferably greater than or equal to 8%" is indefinite for reasons stated above with claim 2.

8. Regarding claim 19, the phrase "especially" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. Also, the language of "rotating roll located more or less vertically" is vague and indefinite and does not clearly describe the structural configuration.

In claim 22, the language of "preferably greater than 7.5 cN/tex" is indefinite for reasons stated above with claim 2.

9. Claim 21 provides for the use of the glass yarn, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 21 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under

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35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-5 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Biefeld, 2,991,196.

Biefeld teaches sized glass fibers that can be in yarn form wherein the sizing composition consists of a solution comprising at least one fatty acid, as required by claim 1. In addition, Biefeld teaches that the fatty acid contains 8-26 carbons and is of the type contemplated by applicants such as octadecadienoic acid, linoleic acid and linolenic acid. See column 1, line 10, and column 2, lines 3-18. Accordingly, the teachings of Biefeld anticipate claims 2-5. Regarding claim 13, this claim set forth a lower limit of 0% by weight. Hence, the teachings of Biefeld necessarily meet this limitation.

Therefore, the teachings of Biefeld anticipate the invention as claimed in present claims 1-5 and 13.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 6-8, 10, 12, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biefeld 2,991,196 as applied above to claims 1-5 and 13, in view of Das et al, 4,351,752 (Das).

Biefeld is a set forth above and additionally teaches that a butadiene-styrene copolymer is added to his sizing composition, but is silent as to the presence of functional groups on his polymer. Das teaches a sizing composition comprising for

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glass strands wherein a polymer such as styrene-butadiene hydroxy derivative can be used and result in better wetting, penetration and encapsulation of the glass fibers treated. See abstract and column 4, lines 33-63. It would have been obvious to one of ordinary skill in this art at the time the invention was made to use as the styrene-butadiene copolymer of Biefeld a styrene-butadiene hydroxy derivative as taught by Das with the reasonable expectation of success of obtaining a sizing composition that would result in better wetting, penetration and encapsulation of the glass fibers. Regarding claims 7 and 24, Das teaches the same type of polymers disclosed by applicants in the instant specification as being suitable. Accordingly, the examiner has reason to believe that the copolymers of Das have a molecular mass within the instant claimed ranges, in the absence of factual evidence to the contrary. As to claims 10 and 12, Das teaches polymer contents within the present claimed ranges, further teaching that coupling agents can be added in the instant claimed ranges as well. Note Examples.

Therefore the combined teachings in Biefeld and Das would have rendered obvious the invention as claimed in present claims 6-8, 10, 12, and 24.

16. Claims 1-20, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al, 4,351,752 (Das) in view of Biefeld, 2,991,196, each as applied above.

Das is as applied above and teaches a sizing composition comprising at least one polymer carrying one or more hydroxyl functional groups, such as butadiene-styrene hydroxy derivative, coupling agent and lubricant, per claims 1, 6-8, 10, 12, 17, and 24. In addition, Das teaches a process essentially as set forth by applicants in

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claim 19 wherein after sizing the fibers are chopped. See column 1, lines 54-63. Das does not teach at least one fatty acid as the lubricant.

Biefeld is as set forth above and teaches a sizing composition for glass fibers in the form of strands, yarns and other forms, said composition comprising styrene-butadiene copolymer and a lubricant, wherein the lubricant is a fatty acid of the type contemplated by applicants in claims 2-5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the lubricant of Das, a fatty acid of the type contemplated by applicants and as taught by Biefeld, motivated by his teachings that exceptional characteristics are secured when the lubricant used in combination with butadiene-styrene copolymer comprises an unsaturated fatty acid. See column 2, lines 3-27. Hence, the combined teachings of Das and Biefeld obviate the invention as claimed in instant claims 1 and 18.

Regarding claims 9, 11, 14, and 16, these claims are drawn to the proportions of the various components. It is the examiner's position that since the result sought and the ingredients used were known, it was within the expected skills of one having ordinary skill in this art to arrive at the optimum proportion of those ingredients. *In re Reese*, 129 USPQ 402 (CCPA 1961).

As to claims 15 and 22, it is the position of the examiner that since the prior art teachings clearly suggest a sizing composition of the type contemplated by applicants, properties such as the viscosity and tensile strength are the same as or substantially

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similar to that contemplated by applicants, in the absence of factual evidence to the contrary. Applicants are invited to provide such evidence.

As to claim 20, Das clearly teaches that it is known in the art to coat glass fibers by spraying. Thus, this limitation is not construed to be a matter of invention.

Regarding claim 23, the combined teachings of Das (chopped sized fibers) and Biefeld (yarns) would have provided a suggestion to the skilled artisan for a staple glass yarn. Moreover, staple fiber yarns are a known configuration for yarns. Accordingly, this limitation is not construed to be a matter of invention in the absence of factual evidence of unexpected or superior properties of the instant staple glass yarn, said properties being directed related to said yarn.

Therefore, the combined teachings of Das and Biefeld would have rendered obvious the invention as claimed in present claims 1-20 and 22-24.

17. Claims 21 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al, 4,351,752 (Das) in view of Biefeld 2,991,196, as applied above to claims 1-20 and 22-24, further in view of Sundt, 2,911,747.

Das and Biefeld are as set forth above but do not teach forming a fabric for a paint canvas. Sundt teaches an artist's canvas having a woven glass cloth base wherein the weave is made from short staple glass fibers. It would have been to use the glass strands of Das and Biefeld in any utility known for glass fiber yarns, such as in the formation an artist's canvas.

No claims are allowed.

Conclusion

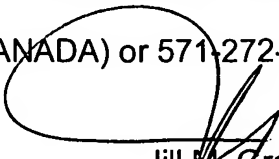
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18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jill M. Gray
Primary Examiner
Art Unit 1774

jmg